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EXAMINER

SUN, SCOTT C

ART UNIT	PAPER NUMBER
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2182

DATE MAILED: 01/24/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/761,075	KREMER, KARL HEINZ	
	Examiner	Art Unit	
	Scott Sun	2182	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 January 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>1/4/2005</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 14 and 25 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

3. Claim(s) 14 and 25 contain the trademark/trade name Portable Document Format™. Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the present case, the trademark/trade name is used to identify/describe ready-for-printer format and, accordingly, the identification/description is indefinite.

4. The following rejections are made based on the examiner's best interpretation of the claims in light of the 35 USC 112 rejections above.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1-9, 11-25 are rejected under 35 U.S.C. 102(e) as being anticipated by Hanson et al (US Patent # 6,407,820; applicant submitted prior art).

7. Regarding claim 1, Hanson discloses a method (figure 1) of printing a document from a digital file, using a plurality of print output devices (image runner, Xerox, xyz printer, and other print output devices collectively designated as element 122), wherein a first print output devices includes a plurality of media sources (column 8, lines 12-14) for supplying media of at least one selected type to a marking engine (print engine, column 7, lines 65-67), and also includes an inserter (collating apparatus, column 19, lines 29-32) for inserting pages of media at selectable locations within pages of an output document printed by the marking engine (column 19, lines 33-37), the method comprising:

Storing an input document in a machine readable form (job origination 102, column 4, lines 6-8);

Identifying at least one page of the stored input document as a special page (color page; column 18, lines 51-54) by assigning a media type to the identified page that differs from the at least one selected type suppliable by the media sources of the first print output device (column 18, lines 40-48; column 19, lines 2-5); Examiner notes that Hanson teaches identifying attributes (color pages used as an example) within a document. The pages are sent to different output devices depending on these attributes. This process is the same as that disclosed by the applicant (figure 2, steps 26-28).

Generating a modified print document from the stored input document, by replacing each of the identified special pages with an insert command to the first print output device to insert a page from its inserter (column 19, 33-37);

Printing the identified special pages using one of the plurality of print output devices to produce at least one printed copy of the special pages (alternate output device; column 19, lines 26-28);

Loading the inserter of the first print output device with the at least one printed copy of the special pages (column 19, lines 37-43);

Printing the modified print document using the first print output device (column 19, lines 33-37); Examiner also directs applicant to applicant's own interpretation of Hanson's teachings (paragraph 10).

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8. Regarding claim 2, Hanson discloses claim 1 and further discloses wherein the identifying step comprises, for each of the special pages, assigning an inserter media type the identified page (column 19, lines 2-5);

9. Regarding claim 3, Hanson discloses claim 2 and further discloses wherein the assigning of an inserter media type to a page of the input document results in an invalid job configuration (column 19; lines 33-37). Examiner notes that applicant discloses invalid job configuration refers to a page requiring "insert" media type (paragraph 43). Because Hanson teaches that exception pages are inserted into the main document, the designation of pages as exception pages is interpreted as invalid job configuration.

10. Regarding claim 4, Hanson discloses claim 1 and further discloses wherein the special pages correspond to pages to be printed in color (column 18, lines 51-55); and wherein the first print output device is a black and white printer (column 18, 31-35). Examiner notes that Hanson teaches (lines 51-55) an automated process of printing color and black and white (B&W) pages on color and B&W printers respectively.

11. Regarding claim 5, Hanson discloses claim 4 and further discloses wherein the step of printing the special print document uses a color print output device (see argument for claim 4 above).

12. Regarding claim 6, Hanson discloses claim 1, and further discloses wherein the special pages correspond to pages having updated content (attributes; column 18, lines 40-44), relative to pages of the stored input document that are not special pages.

13. Regarding claim 7, Hanson discloses claim 1, and further discloses wherein the identifying step comprises: viewing pages of the stored input document via a graphical

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user interface (desktop application shown in figure 4) at a computer resource; selecting one or more of the special pages of the input document (column 18, lines 40-44); assigning, to the selected one or more pages, the media type that differs from the at least one selected type suppliable by the media sources of the first print output device (column 18, lines 51-55; also see rejection for claim 4 above). Examiner notes that designating pages as exception pages requiring a different output device is a media type that differs from the selected type suppliable by the media sources of the first print output device (color pages in a B&W document).

14. Regarding claim 8, Hanson discloses claim 7, and further discloses wherein the viewing step (figure 4) comprises executing, upon the computer resource, a companion (plug in) application (desktop 302, column 13, lines 26-27) in combination with an authoring application (viewer 306), wherein a first GUI window (viewer 306) corresponding to the authoring application appears in combination with a second GUI interface window (desktop 302) corresponding to the companion application. Examiner notes that figure 4 shows both desktop portion and viewer portion of the GUI being connected to each other.

15. Regarding claim 9, Hanson discloses claim 8, and further discloses wherein the pages of the stored input document are viewed within the first GUI (figure 4; column 13, lines 50-53).

16. Regarding claim 11, Hanson discloses claim 9, and further discloses wherein the assigning step is performed by selecting the media type using the second GUI window ("print settings B2", figure 4; column 16, lines 49-52).

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17. Regarding claim 12, Hanson discloses claim 1, and further discloses wherein the stored input document is in a ready-for-printer format (column 5; lines 47-50).

18. Regarding claim 13, Hanson discloses claim 1, and further discloses wherein the special print document and the modified printer document are in a ready-for-printer format (column 5; lines 47-50). Examiner notes that Hanson teaches all documents are converted into a "ready for printer" format.

19. Regarding claim 14, Hanson discloses claim 13, and further discloses wherein the ready-for-printer format is the Portable Document Format (column 5, lines 50-53).

20. Regarding claim 15-25, examiner finds these claims substantially similar to claims 1-9, 11-14. The same arguments are used. A note is made regarding claim 19, and specifically regarding the limitation "network server" which can be found in figure 1 as document library (118), described in column 3, line 56 and column 6, lines 26-28.

Claim Rejections - 35 USC § 103

21. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

22. Claim 10 is rejected under 35 U.S.C. 103(a) as being obvious over Hanson in view of Microsoft Windows XP (See attached screenshot).

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23. Regarding claim 10, Hanson discloses claim 9, but does not disclose explicitly wherein the first GUI corresponds to a thumbnail view of a plurality of pages of the stored input document. However, examiner asserts that thumbnail views of documents were well known in the art at the time of invention. An example is Microsoft Windows XP in which documents can be viewed as thumbnails. Windows XP provides a GUI and is in the same field as Hanson's teachings of a GUI.

Therefore, it would have been obvious for a person of ordinary skill at the time of invention to implement thumbnail view feature in GUI system of Hanson's invention for the benefit of viewing, editing, organizing, and otherwise manipulating multiple documents simultaneously.

Conclusion

1. Other publications are cited to further show the state of the art with respect to printers, and specially insertion into a document to be printed. Refer to form 892, "Notice of References Cited", for a complete list of relevant prior arts cited by the examiner.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Scott Sun whose telephone number is (571) 272-2675. The examiner can normally be reached on M-F, 10:30am-7pm.


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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim N. Huynh can be reached on (571) 272-4147. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

SS

1/12/2006


KIM HUYNH
SUPERVISORY PATENT EXAMINER
1/13/06